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09/823,041	03/30/2001	Francois Gugumus	A-22181/US/A	1010

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CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/P23,041

Applicant(s)

GUGUMUJ

Examiner

T. Yoon

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-15 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☒ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Relocation of (IIb) for the 2-hydroxyphenylbenzotriazole in claim 3 is needed.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter; "The use of". A method of using is suggested.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "type" in claims 1 and 14 is indefinite. It is unclear what additional species are allowed into the genus of the terminology modified by "type". The word "type" therefore makes the modified terminology indefinite. See *Ex parte Copenhaver*, POBA, 1955, 109 USPQ 118-119.

The recited polypropylene in claim 2 is confusing and improperly broadens the scope of claim 1. Also, it is unclear whether the recited "the polyolefin" refers to "polyolefin" in line 1 or 3 of claim 1.

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 14 recites the broad recitation hindered amine, and the claim also recites "in particular an amine of this type ---" which is the narrower statement of the range/limitation.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 9193322.

The translated copy of JP (and UK examination report) teaches a polyethylene made by using metallocene catalyst (0007) and a mixture of SUMISORB 130 (2-hydroxy-4-octyloxybenzophenone) and SUMISORB 200 (2-(2-hydroxy-5-methylphenyl)benzotriazole) (examples 2 and 3 of table). The recited definitions in claims 6-9 and 11 are optional when combined with claim 3.

Thus, the instant invention lacks novelty.

Claims 1-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 9193322 in view of Birbaum et al (US 5,736,597) or Renz et al (US 6,191,199).

The instant invention further recites other species of benzophenones and benzotriazoles over JP. However, such benzophenones and benzotriazoles as stabilizers for polyolefins are well known in the art as taught by Birbaum et al (col. 41, line 56 to col. 42, line 4) and Renz et al (col. 17, lines 27-40).

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It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the art well known stabilizers taught by Birbaum et al and Renz et al in JP since JP teaches the use of a mixture of benzophenones and benzotriazole which encompass other benzophenones and benzotriazoles and since the benzophenone and benzotriazole used in JP are taught as examples. Note that reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples. *In re Mills*, 477 F2d 649, 176 USPQ 196 (CCPA).

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birbaum et al (US 5,736,597), Avar et al (US 4,891,396) or Renz et al (US 6,191,199) alone, or in view of JP 9193322, Musser et al (US 4,524,165), Jollenbeck et al (US 5,498,345), WO 97/39052 or Luethi et al (US 3,529,982).

Birbaum et al (abstract, col. 36, line 63 to col. 37, line 32, col. 41, line 56 to col. 42, line 28), Avar et al (abstract, col. 2, lines 42-43 and col. 3, lines 5-6 and 39-43,) and Renz et al (abstract, col. 17, lines 26-40, col. 18, lines 11-30 and col. 23, lines 6-20) teach employing mixture of stabilizers recited in the instant invention for stabilizing polyolefins.

JP 9193322 (examples 2-3), Musser et al (tables I-V), Jollenbeck et al (abstract and examples) and WO 97/39052 (table 1 and 2) teach the use of mixed stabilizers for stabilizing polymers, and Luethi et al (col. 2) teaches the instant oxanilide.

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It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the art well known mixtures of stabilizers recited in the instant invention in Birbaum et al, Avar et al, or Renz et al with or without teaching of JP 9193322, Musser et al, Jollenbeck et al, WO 97/39052 or Luethi et al since Birbaum et al, Avar et al and Renz et al teach employing stabilizer mixtures and since choosing species from the disclosed species is considered a *prima facie* obviousness and since the method of stabilizing polymers, any polymer in fact, by utilization of stabilizer mixtures in order to obtain a synergistic effect is a routine practice in the art as evidenced by JP 9193322, Musser et al, Jollenbeck et al, WO 97/39052 and Luethi et al. taught by Birbaum et al and Renz et al in JP since JP teaches the use of a mixture of benzophenones and benzotriazole which encompass other benzophenones and benzotriazoles and since the benzophenone and benzotriazole used in JP are taught as examples.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/March 13, 2003



TAE H. YOON
PRIMARY EXAMINER